

Doc No P280447 701750-Dkt419
Serial No. 09/931,170**REMARKS**

Claims 1-8, 12-21, and 23-24 are pending in the application. Claims 9-11 and 22 are cancelled. Claims 1 and 5 are amended. Favorable reconsideration is respectfully requested in light of the following Remarks.

Claim Rejections - 35 U.S.C. § 112:

Claims 1-8, 12-17, and 24 were rejected under 35 U.S.C. § 112, first paragraph. The Office Action stated that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. In particular, it was found that the specification, while being enabling for cooling the entire molded sheet such that it becomes hard and resilient and suitable for use as an exterior body panel, does not reasonably provide enablement for cooling the thermoplastic material on the side opposite the transparent layer such that it becomes sufficiently rigid to form an exterior body panel.

Applicant respectfully traverses this rejection. The claims do not support such a reading of the claims. In fact, claim 1 recites "cooling the laminate" and claim 5 recites "cooling the pressed laminate" and not as stated in the Office Action a cooling of just the thermoplastic material on the side opposite to the transparent layer. However, to more clearly define the present invention, Applicant amended claims 1 and 5 to replace the phrase "when cooled" with the phrase "when the laminate is cooled". Thus, Applicant submits that the specification is enabling and that the claims are supported by the specification.

In view of the foregoing, Applicant submits that claims 1 and 5 are allowable and requests that their rejection be withdrawn. Claims 2-4, 12, 14, 16 and 24 which ultimately depend from claim 1 and claims 6-8, 13, 15, and 17 which ultimately depend from claim 5 are likewise allowable for at least the reason discussed above. Withdrawal of their rejection is respectfully requested.

Doc. No. P280447 701750-Dkt419
Serial No. 09/931.170Claim Rejections - 35 U.S.C. § 103:

Claims 1-4, 12, 14, 16, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller (U.S. Patent No. 5,230,906) in view of Ellison (U.S. Patent No. 6,399,193).

Applicant respectfully traverses the rejection of claims 1-4, 12, 14, 16, and 24 as being unpatentable over Mueller in view of Ellison.

Mueller discloses a method and an apparatus for preparing fiber-reinforced plastic articles. In doing so, a fibrous web is impregnated under subatmospheric pressure with a liquid, curable resin composition to form a so-called prepreg. The liquid resin composition is contained within a trough and the fibrous web is passed through this trough and leaves the resin bath in a fully impregnated state. This process creates a prepreg that has a top and bottom layer equal in composition and thickness. The prepreg is then covered on both sides with a thin protecting sheet of polyvinyl alcohol (PVA). The prepreg may then be heated to accelerate the speed of the viscosity increase of the resin before cutting the prepreg into pieces of appropriate length. Then, the prepreg is shaped within a vacuum mold and pre-cured. The shaped and pre-cured prepreg is removed from the mold and finally completely cured outside the mold. After the curing of the prepreg is completed, the PVA sheets are peeled off again, and the cured article is cut into size. In this way, construction elements are formed in accordance with Mueller.

Claim 1, *inter alia*, specifies a decorative web layer. Mueller discloses merely a functional web. There is no mention in Mueller of a decorative effect created by the fibrous web. As disclosed in the specification as originally filed, the present invention provides a strong, cost-effective, decorative exterior body panel for use on automotive vehicles. To further ease the process of production of the vehicle body, and to provide an aesthetically pleasing appearance, the panel has an integral decorative material. Such a panel does not require paint or other extra steps to provide a finished look to the vehicle body. Thus, once the body panels are produced, they may simply be fastened to a vehicle frame without further processing.

Furthermore, by passing the fibrous web through a trough, a prepreg is created that has a top and bottom layer equal in composition and thickness. In accordance with the present invention as defined in claim 1, a thermoplastic material is provided on a top side of the decorative web layer and on a bottom side of the decorative web layer. Thus, the present invention can provide a top and bottom layer different in thickness and composition.

In addition, claim 1, *inter alia*, specifies the forming of a laminate by providing a thermoplastic material. Mueller discloses the formation of a prepreg by impregnating a fibrous web with a thermosetting resin including a monomeric crosslinking agent, *col. 3, lines 39-53*. The enclosure of the prepreg between thin sheets of polyvinyl alcohol as a protective layer is only temporary. Nevertheless, PVA is not generally considered as a thermoplastic material because the melt temperature exceeds the degradation temperature for fully hydrolysed grades. After the prepreg is completely cured, the PVA sheets are removed again. Thus, the final articles manufactured by the method of Mueller are limited to thermosetting resins.

Furthermore, claim 1 specifies, *inter alia*, that at least one of the top side and bottom side being substantially transparent. Mueller does not provide any disclosure that at least one of the top side and bottom side is being substantially transparent. Ellison discloses a paint film having a clear coat layer, a colored layer including an adhesive and at least one color pigment, and a support layer of an extruded film adhered to the color layer. The mere disclosure of a clear coat layer provided on top of an adhesive including a color pigment, in accordance with Ellison, does not provide sufficient motivation to combine the references of Mueller and Ellison. Doing so, employs improper hindsight using the Applicant's own teaching. There is no suggestion or incentive in Mueller and Ellison that support this combination. Furthermore, as discussed heretofore, the teachings of Mueller and Ellison combined do not produce the claimed invention.

Additionally, the Office Action states that "Mueller and Ellison are combinable because they are analogous with respect to laminates used for automobiles." This statement is not true, even if it is assumed that Mueller and Ellison are analogous art. Merely because two pieces of prior art may be analogous art does not necessarily mean

Doc No. P280447 701750-Dkt419
Serial No. 09/931,170

that the two pieces of art are properly combinable, and it certainly does not mean that the two pieces of art are properly combinable to satisfy particular claim limitations.

The method of the present invention as defined in claim 1 provides an in-line process for making exterior body panels from a decorative web layer to a finished product. The decorative web layer in accordance with the present invention provides for more variety of decorative appearance, such as patterns, reflective appearance, textured appearance or combinations thereof. Thus, the present invention fulfills a commercial need for exterior body panels that cannot be met by Ellison or Mueller alone or combined.

For at least these reasons, Claim 1 is allowable over the applied art. Claims 2-4, 12, 14, 16, and 24, which ultimately depend from Claim 1, are likewise allowable over the applied art. Withdrawal of the rejection is respectfully requested.

Claims 5-8, 13, 15, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller (U.S. Patent No. 5,230,906) in view of Ellison (U.S. Patent No. 6,399,193). The rejection is respectfully traversed.

The teaching of Mueller was discussed in more detail herein above.

Claim 5 specifies, *inter alia*, a layer of decorative web material. Mueller discloses merely a functional web. There is no mention in Mueller of a decorative effect created by the fibrous web.

Furthermore, claim 5 specifies, *inter alia*, the steps of depositing on one side of the decorative web material a mixture of epoxy and plastic for forming a plastic layer that is substantially transparent and depositing on an opposite side of the decorative web material a mixture of epoxy and plastic for forming a plastic layer. Thus, in accordance with the present invention a top and bottom layer may be provided that are different in thickness and composition. In Mueller, the fibrous web is passed through a trough uniformly impregnating the web with a same thermosetting resin.

Moreover, claim 5 specifies, *inter alia*, a plastic layer that is substantially transparent. Mueller does not provide any disclosure of a plastic layer being substantially transparent. Ellison discloses a paint film having a clear coat layer, a colored layer including an adhesive and at least one color pigment, and a support layer of an extruded

Doc No. P280447 701750-Dkt419
Serial No. 09/931,170

film adhered to the color layer. The mere disclosure of a clear coat layer provided on top of an adhesive including a color pigment, in accordance with Ellison, does not provide sufficient motivation to combine the references of Mueller and Ellison. As stated heretofore, doing so, employs improper hindsight using the Applicant's own teaching. There is no suggestion or incentive in Mueller and Ellison that support this combination. Furthermore, as discussed heretofore, the teachings of Mueller and Ellison combined do not produce the claimed invention. Also, as stated above, contrary to the statement in the Office Action, Mueller and Ellison are not combinable merely because they may be analogous art.

Thus, Applicant submits that claim 5 is allowable and that the rejection be withdrawn.

Claims 6-8, 13, 15, and 17 which ultimately depend from claim 5 are likewise submitted to be allowable for at least the reasons discussed above. Withdrawal of their rejection is respectfully requested.

Claims 18-21 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller (U.S. Patent No. 5,230,906) in view of Ellison (U.S. Patent No. 6,399,193). The rejection is respectfully traversed.

A more detailed discussion of Mueller and Ellison was provided herein above in conjunction with the arguments presented in defense of claims 1 and 5. The same arguments are applicable in the defense of claim 18.

Claim 18 specifies, *inter alia*, a decorative web layer. Mueller discloses merely a functional web. There is no mention in Mueller of a decorative effect created by the fibrous web.

The prepreg prepared by the method of Mueller is obtained by impregnating a web with a thermosetting resin. Claim 18 specifies, *inter alia*, that a laminate is formed by providing a mixture of an epoxy and a thermoplastic material on a top side and on a bottom side of the decorative web layer. Thus, the present invention may provide a top and bottom layer different in thickness and composition.

Doc. No. P280447 701750-Dkt419
Serial No 09/931,170

Furthermore, claim 18, *inter alia*, specifies the forming of a laminate by providing a thermoplastic material. Mueller discloses the formation of a prepreg by impregnating a fibrous web with a thermosetting resin.

Furthermore, claim 18 specifies, *inter alia*, that at least one of the top side and bottom side is being substantially transparent. Mueller does not provide any disclosure that at least one of the top side and bottom side is being substantially transparent. The mere disclosure of a clear coat layer provided on top of an adhesive including a color pigment, in accordance with Ellison, does not provide sufficient motivation to combine the references of Mueller and Ellison. Doing so, employs improper hindsight using the Applicant's own teaching. There is no suggestion or incentive in Mueller and Ellison that support this combination. Also, as stated above, contrary to the statement in the Office Action, Mueller and Ellison are not combinable merely because they may be analogous art. Furthermore, as discussed heretofore, the teachings of Mueller and Ellison combined do not produce the claimed invention.

Thus, Applicant submits that claim 18 is allowable for at least the reasons discussed heretofore. Claims 19-21, and 23 which ultimately depend from claim 18 are likewise submitted to be allowable for at least the reasons discussed above. Withdrawal of their rejection is respectfully requested.

Claim 5 is voluntarily amended to more clearly define the invention. The phrase "which when cured forms a plastic layer" is replaced with the phrase "for forming a plastic layer".

In view of the foregoing, it is respectfully submitted that the application is in condition for Allowance. Favorable reconsideration and prompt Allowance of the Application is earnestly solicited.

Should Examiner Lee believe anything further would be desirable in order to place the Application in better condition for Allowance, the Examiner is invited to contact the undersigned attorney at the telephone number listed below.

Doc. No P280447 701750-Dkt419
Serial No 09/931,170

As this response has been timely filed within the set period of responses,
no petition for extension of time or associated fee is required.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By: 

Thomas P. Hilliard
Reg. No. 40,330
Tel. No.: 703.905.2091
Fax No.: 703.905.2500

TPH:ml

P.O. Box 10500
McLean, VA 22102
Tel. No.: 703.905.2000

CERTIFICATE OF FACSIMILE TRANSMISSION

*I hereby certify that this paper is being facsimile transmitted to the Patent
and Trademark Office on the date shown below.*

Name Thomas P. Hilliard

Sig. 

Date Sept. 3, 2004

50178/280447

C# / M#